

BoxInterferences@uspto.gov  
Telephone: 571-272-4683

Paper 23  
Entered: 22 January 2008

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

Patent Interference 105,599 McK  
Technology Center 1700

---

SE-HWAN SON, OK-HEE KIM, SEOK-HEE YOON,  
KONG-KYEOM KIM, YOUN-GU LEE and JAE SOON BAE

Application 10/798,584,  
US Patent Publication 2004/0169175 A1  
Junior Party,

v.

KAZUNORI UENO, AKIHIRO SENOO,  
and SEIJI MASHIMO,

Patent 6,436,559 B1,  
Senior Party.

---

*Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER  
and MOORE, Administrative Patent Judges.*

*McKELVEY, Senior Administrative Patent Judge.*

**JUDGMENT**

**A. Conference Call**

A conference call was held on 17 January 2008 at approximately 2:00  
(1400 hours) p.m. (EST).

1           **B. Relevant Discussion during the Conference Call**

2           The principal purpose of the conference call was to authorize motions.  
3   Upon consideration of the discussion during the conference call, it became  
4   apparent that Son was requesting entry of an adverse judgment as to  
5   Count 1. The parties were advised that the Board would enter a judgment.

6           In its motions list, Son listed motions to file amendments to the  
7   involved Son application. Papers have been filed indicating the nature of the  
8   amendments proposed to be made. Papers 20 and 21.

9           Paper 20 shows that Son would amend involved claims 1 and 12 of  
10   the involved Son application to (1) exclude from claims 1 and 12 organic  
11   compounds having R's which are (a) hydrogen or (b) aromatic hydrocarbons  
12   which are phenyl (e.g., the claim would be limited to "aromatic  
13   hydrocarbon, except phenyl") and (2) limit C<sub>1</sub>-C<sub>12</sub> hydrocarbon to C<sub>9</sub>-C<sub>12</sub>  
14   hydrocarbon. See Count 1 for the general structural formula of the "organic  
15   compound." Paper 1, page 8.

16          Paper 21 shows that new proposed claims 21-28 would limit the  
17   "organic compound" to one in which all the R's (see Count 1, Paper 1,  
18   page 8) are cyano (—CN).

19          The amendments will not be entered in the interference. However,  
20   when *ex parte* prosecution resumes, Son is free to present proposed amended  
21   claims 1 and 12 and proposed claims 21-28. Whether the Examiner would  
22   enter the amendment in the involved Son application or require an RCE or  
23   the filing of a continuing application is a matter to be determined by the  
24   Examiner. Also, at this point, we have no occasion to express any views as  
25   to (1) whether proposed amended claims 1 and 12 would be patentable over  
26   the count [*In re Deckler*, 977 F.2d 1449 (Fed. Cir. 1992) (party losing  
27   interference is not entitled to claims to same patentable invention as count;

1 *Ex parte Tytgat*, 225 USPQ 907 (Bd. App. 1985) (same)] or (2) whether  
2 any other estoppel under 37 C.F.R. § 41.127(a) (2007) might be applicable.

3 Counsel for Son also advised that there are other Son applications  
4 which contain claims which may be unpatentable over Count 1. *See*  
5 Paper 23. Counsel indicated that he would advise the examiners in each  
6 of those applications about the "lost" Count.

7 **C. Judgment**

8 Upon consideration of the discussion during the conference call, it is  
9 ORDERED that judgment on priority as to Count 1 (the sole  
10 count in the interference; Paper 1, page 8) is awarded against Junior Party  
11 SE-HWAN SON, OK-HEE KIM, SEOK-HEE YOON, KONG-KYEOM  
12 KIM, YOUN-GU LEE and JAE SOON BAE.

13 FURTHER ORDERED that Junior Party SE-HWAN SON,  
14 OK-HEE KIM, SEOK-HEE YOON, KONG-KYEOM KIM, YOUN-GU  
15 LEE and JAE SOON BAE, is not entitled to a patent containing claims 1-4,  
16 9-16 and 18-20 (corresponding to Count 1) of:

17 application 10/798,584  
18 filed 10 March 2004  
19 US Publication 2004/0169175 A1  
20 published 02 September 2004

21 FURTHER ORDERED that if there is a settlement agreement,  
22 attention is directed to 35 U.S.C. § 135(c).

23 FURTHER ORDERED that a copy of this JUDGMENT shall  
24 be placed in the files of (1) Son application 10/798,584 and (2) Ueno Patent  
25 6,436,559 B1.

1                   FURTHER ORDERED that the Clerk is directed to distribute  
2 the files upon entry of this JUDGMENT.

3

4

5

6                   /ss/ Fred E. McKelvey )

7 FRED E. McKELVEY )

8 *Senior Administrative Patent Judge* )

9 )

10 /ss/ Richard E. Schafer )

11 RICHARD E. SCHAFER )

12 *Administrative Patent Judge* )

13 )

14 /ss/ James T. Moore )

15 JAMES T. MOORE )

16 *Administrative Patent Judge* )

BOARD OF

PATENT

APPEALS

AND

INTERFERENCES

1 cc (via Electronic Mail):  
2  
3 Attorney for Son  
4 (real party in interest LG Chemical Co., Ltd.)  
5  
6 Mark R. Kresloff, Esq.  
7 Song K. Jung, Esq.  
8 McKenna Long & Aldridge LLP  
9 1900 K Street, N.W.  
10 Washington, D.C. 20006  
11  
12 Tel: 202-496-7500  
13 Fax: 202-496-7756  
14 Email: mkresloff@mckennalong.com  
15 Email sjung@mckennalong.com  
16  
17 Attorney for Ueno  
18 (real party in interest Canon Kabushiki Kaisha)  
19  
20 Anthony M. Zupcic, Esq.  
21 Robert H. Fischer, Esq.  
22 FITZPATRICK CELLA HARPER & SCINTO  
23 30 Rockefeller Plaza  
24 New York, N.Y. 10112-3800  
25  
26 Tel: 212-218-2100  
27 Fax: 212-218-2200  
28 Email: azupcic@fchs.com  
29 Email: rfischer@fchs.com